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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,513	04/01/2004	E. James Arking	IK-120(US)	8227
7590 11/28/2008 KELLEY DRYE & WARREN LLP 400 ATLANTIC STREET, 13TH FLOOR STAMFORD, CT 06901				
EXAMINER				
AKRAM, IMRAN				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
11/28/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,513

Applicant(s)

ARKING ET AL.

Examiner

IMRAN AKRAM

Art Unit

1795

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 11/18/08 have been fully considered but they are not persuasive. The Pelecq reference still applies, albeit in different form necessitated by amendment.
2. Applicant argues on page 9 of the Arguments that Pelecq does not disclose that the "fluid transport is being generated by a force on shaft from back end" as the amended claim states. Examiner respectfully disagrees. The contents may be propelled out of the container through internal pressure, as Applicant argues, but they still require an external push of push button 7 (Paragraph 3 on page 6 of translation).
3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a piston ring type slideable seal or a continuous seal) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The head is slideable and sealing (paragraph 5, page 5), therefore it anticipates the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 6, 7, and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Pelecq (FR 2537092). Line references will refer to previously provided translation.
6. Regarding claim 1, Pelecq discloses a device having a head (not labeled, but object **22** is attached to) with head surface at the forward end of the head and a shaft **24** on the back end (see figure 2), the head being configured to form a slideable seal with the inside surface of a sample tube (paragraph 5, page 5), a collection port **12** disposed forward of the head surface (see figure 2), and a fluid passageway **15** in fluid communication with the collection port; said fluid transport being generated by a force on said shaft from said back end (paragraph 3 on page 6); a head surface positioned inside a sample tube **3** and a plenum space bounded by the head surface, the collection port, and the inner surface of the tube (page 3, lines 6-11).
7. Regarding claim 3, Pelecq discloses that the head is configured for use with a sample tube having a predetermined sample tube cross-section; the collection port has a predetermined collection port cross-section; and the ratio of the collection port cross-section to the sample tube cross-section of 1:10 (see figure 1).
8. Regarding claim 6, Pelecq discloses a collection port placed at the center of the head (see Figure 2).
9. Regarding claim 7, Pelecq discloses a collection port configured to isolate the head surface from a sample during collection of the sample from the sample tube (see Figure 3).

10. Regarding claims 17 and 18, since no fluid sample is explicitly claimed as part of the fractionator apparatus, any such fluid can be used in the device of Pelecq.
11. Regarding claim 19, Pelecq discloses that said force affecting fluid transport is applied manually (paragraph 3, page 6).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pelecq.

16. Pelecq does not disclose a sample container at least 25 times larger in cross-section than the collection port. Pelecq, however, shows in Figure 1 that a sample container can have a varying cross-sectional size and be fit for the fractionator but as large as necessary beneath it. It would have been obvious to one having ordinary skill in the art at the time of invention to use a larger container--as long as it's predetermined neck size for the predetermined collection port size—for the larger volume of sample.

Also see MPEP 2144.04 IV, A.

17. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pelecq as applied to claim 1 above, and further in view of Kodarar (US 5,649,647).

18. Pelecq does not disclose the collection port to be off center from the center of the head. Kodarar--in an invention for fluid transfer from vessels--discloses the use of an off centered collection port using two fluid passageways (see figure 1). Pelecq discloses an outlet passageway **14**, but not parallel to the fluid passageway **15**. Kodarar runs the passageways parallel in order to feed to containers that are generally lower (see abstract). It would have been obvious to one having ordinary skill in the art at the time of invention to run the outlet passageway of Pelecq parallel to the fluid passageway as in Kodarar in order to more easily dispense to lower container as it would make use gravity more effectively, thereby shifting the collection port off-center to accommodate.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IMRAN AKRAM whose telephone number is (571)270-3241. The examiner can normally be reached on 10-7 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexa Neckel can be reached on 571-272-1446. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/IA/

/Alexa D. Neckel/
Supervisory Patent Examiner, Art Unit 1795